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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,772	07/21/2003	Marc Rohrschneider	740116-490	4231
22204	7590	05/26/2005	EXAMINER	
NIXON PEABODY, LLP			KIM, CHRISTOPHER S	
401 9TH STREET, NW			ART UNIT	
SUITE 900			PAPER NUMBER	
WASHINGTON, DC 20004-2128			3752	

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/622,772

Applicant(s)

ROHRSCHEIDER, MARC

Examiner

Christopher S. Kim

Art Unit

3752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 7,9-11,15,20-22,27,28,38 and 40-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,12-14,16-19,23-26,29-37,39,43 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/21/03; 5/13/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species C, figure 3 in the reply filed on May 4, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 7, 9-11, 15, 20-22, 27, 28, 38 and 40-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 4, 2005.

### ***Oath/Declaration***

3. Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on an application filed in Great Britain on August 1, 2002. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-6, 8, 12-14, 16-19, 23-26, 29-37, 39, 43 and 44 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the "cylinder" being part of the "actuator", does not reasonably provide enablement for the "cylinder" and "actuator" being separate elements. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The specification and the drawings appear to disclose the cylinder 3 being within actuator 9.

6. Claims 1-6, 8, 12-14, 16-19, 23-26, 29-37, 39, 43 and 44 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the "passageway means" being part of the "piston", does not reasonably provide enablement for the "passageway means" and "piston" being separate elements. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The specification and the drawings appear to disclose passageway means 7 formed by piston 6.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-6, 8, 12-14, 16-19, 23-26, 29-37, 39, 43 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 35 recite "a cylinder" and "a finger operated actuator." They appear to be a double inclusion because the cylinder is part of the actuator.

Claims 1 and 35 recite "a piston" and "a passageway means." They appear to be a double inclusion because the piston forms the passageway means.

The term "highly" in claim 18 is a relative term which renders the claim indefinite. The term "highly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is uncertain what pressures the plastic must resist to constitute a "highly pressure resistant plastic."

Claim 35 recites "...up to at least..." in line 30. The phrase appears to be contradictory. The phrase "up to" signifies a maximum while "at least" signifies a minimum.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 1-6, 8, 12-14, 16-19, 24, 25, 29-37, 39, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aftergut (1,517,932).

Aftergut discloses, in figure 1, a finger operated spray pump comprising: a liquid reservoir 1; an atomizer 14; a cylinder 5, 6; a piston 3; a passageway means 7, 12; a one way valve means 9; a finger operated actuator 6; a dip tube 8; a second one way valve means 15.

Specifically regarding claims 1, 30, 31, 32 and 35:

Aftergut does not specifically disclose the diameter of the cylinder or the diameter of the nozzle, but Aftergut recognizes, on page 1, lines 94-100, the desirability of adapting the invention to bottles of different sizes.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a piston and cylinder diameter between 0.5 mm and 4.0 mm to accommodate smaller/larger bottles, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a nozzle diameter between 15  $\mu$ m and 150  $\mu$ m to accommodate smaller/larger bottles, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Specifically regarding claims 2, 3 and 36:

Aftergut does not specifically disclose the stroke length.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a stroke length between 2 mm and 30 mm to accommodate smaller/larger bottles, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Specifically regarding claims 4-6, 33, 34 and 37:

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Specifically regarding claims 12, 13, 43 and 44:

Aftergut does not specifically disclose the piston internal diameter.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a stroke length between 0.2 mm and 3.0 mm to accommodate smaller/larger bottles, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Specifically regarding claims 14 and 16-18:

Aftergut does not specifically disclose metal, aluminum and pressure resistant plastic. Metal, aluminum and plastics are well known materials in the art. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have made the device of Aftergut from metal, aluminum or pressure resistant plastic for durability.

All piston/passageway means possess some degree of capillary property.

Specifically regarding claim 29:

Aftergut does not disclose a return spring in the embodiment of figure 1 but does disclose a spring 23 in the embodiment of figure 2.

It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided a return spring in Aftergut's embodiment of figure 1 to automatically return the actuator to the upper position (page 2, lines 16-18).

11. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aftergut (1,517,932) in view of Nozawa et al. (4,530,449).

Aftergut discloses the limitations of the claimed invention with the exception of the filter. Nozawa discloses a filter 48 between nozzle outlet 44 and second valve 36. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the filter of Nozawa to the device of Aftergut to prevent solids from reaching the nozzle outlet (Nozawa, column 4, lines 50-54).

12. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aftergut (1,517,932) in view of Corsette (4,050,613).

Aftergut discloses the limitations of the claimed invention with the exception of the air vent means. Corsette discloses an air vent means 17. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the air vent means of Corsette to the device of Aftergut to permit equalization of pressures (Corsette, column 3, lines 24-25).




***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Kim whose telephone number is (571) 272-4905. The examiner can normally be reached on Monday - Thursday, 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel can be reached on (571) 272-4919. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Christopher S. Kim  
Primary Examiner  
Art Unit 3752

CK